

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1-21 remain pending in this application. Claims 14 and 21 have been amended.

In the Examiner's Official Action, the Examiner rejects the pending claims over, *inter alia*, German Publication 20020292 and German Publication 19805790. English translations of these documents have been obtained by the applicant/owner. While the undersigned cannot be certain of the source of these translations or their accuracy, on information and belief, the translations are sufficiently accurate to yield a good understanding to the skilled artisan of the disclosed and illustrated structures. Copies of the English translations are therefore attached together with a form PTO-1449 listing the same. Because the German language documents have already been cited and considered by the Examiner, and made of record, it is not believed that an IDS fee is required for the translations to be fully considered by the Examiner and for the Examiner to acknowledge consideration thereof by returning an initialed copy of the herewith Form PTO-1449. If the undersigned's understanding is incorrect, however, and a fee is required, please charge the same to our Deposit Account No. 14-1140 under Order No. 25-335.

In the Official Action, claims 14-20 were rejected by the Examiner under 35 USC 103(a) as obvious over German Publication No. 20020292 ('292 Publication) in view of French Patent No. 2306931 ('931 Patent). The Applicant respectfully requests reconsideration of this rejection for the reasons set out below.

Claim 14, as amended, is directed to an improved side shift assembly which protects the side shift operator means from possible damage caused by the forks or the load thereon. The side shift operator means consists of moving parts which are

vulnerable to this type of damage. As recited in claim 14, the protection is provided by a planar front portion of the upper cross member which is positioned between the side shift operator means and the forks.

In order to prove obviousness, a challenger must present prior art references which disclose the claimed subject matter of the patent/application in question. If separate prior art references each disclose separate elements of a claim, the challenger must also show some teaching, suggestion, or incentive in the prior art that would have led one of ordinary skill in the art to make the claimed combination. See, e.g., Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 304-05 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). In determining obviousness, there must be some reason other than hindsight for selectively combining the prior art references to render the claimed invention obvious. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

The '292 Publication discloses a side shift assembly with side shift cylinders (which are the side shift operator means disclosed in the '292 Publication) located in the frame support member. However, as best shown in Figure 2 of the '292 Publication, the upper cross member of the side shift frame does not include any portion which protects or shields the side shift cylinders from the forks or load. The side shift cylinders are exposed to potential damage.

The Examiner has cited the '931 Patent solely for the disclosure of piston pads. Consequently, this reference does not appear to be relevant to claim 14. Nevertheless, the disclosure of the '931 Patent, as it relates to claim 14, is discussed below for the purpose of completeness.

The '931 Patent discloses a side shift frame which hangs on to a plate attached to the carriage (see Abstract). The side shift operator means of the '931 Patent is not located within the carriage, but is secured to the outer surface of the plate between the horizontal members of the side shift frame. As clearly shown in Figure 1 of the '931

Patent, the side shift cylinders are exposed, and no portion of the side shift frame is provided between the side shift cylinder and forks to protect the side shift cylinders from the forks.

Thus, neither of the above references (individually or in combination) disclose a planar front portion of the upper cross member of the side shift frame which is located between the side shift operator means and the forks to protect the side shift operator means from the forks or the load thereon.

For all of the above reasons, claims 14-20 of the present application are not obvious in light of the '292 Publication and the '931 Patent.

Claims 1-13 and 21 were rejected by the Examiner under 35 USC 103(a) as obvious over the '292 Publication in view of the '931 Patent, and further in view of "Behind Every Movement There is A Idea" brochure (Brochure) and German Publication No. 19805790 ('790 Publication). The Applicant respectfully requests reconsideration of this rejection for the reasons set out below.

Claims 1 and 21 are directed to a side shifter capable of fork positioning functionality which reduces lost load by positioning the forks where the rear surface thereof is no further forward than the front face of the upper cross member of the side shift frame. Claim 21 has been amended to clarify that a sliding surface is provided on the lower cross member of the side shift frame (this limitation was already included in Claim 1). The fork shoes slide horizontally on the sliding surface during fork positioning.

The Examiner's position appears to be that Claims 1 and 21 are obvious in view of the side shifter disclosed in the '292 Publication in combination with the fork positioners disclosed in either the '790 Publication or the Brochure.

The side shifting assembly disclosed in the '292 Publication is directed to reducing frictional forces between the carriage and the side shift frame to permit more

precise and jolt-free sliding movement (see 4th paragraph of page 2 of the English translation). This is accomplished by the use of a number of balls on which the side shift frame slides (see Fig. 4, part 62). The '292 inventors suggest that their invention would also permit replacing hydraulic systems with an electric motor to drive the side shift frame. This embodiment of their invention would require that that no other functionality other than side shifting is provided (see last line of pg. 3 and first line of pg. 4 of English translation). Accordingly, the invention disclosed in the '292 Publication teaches away from combining the side shifter disclosed therein with any fork positioner.

In addition, any fork positioner combined with the side shifter of the '292 Publication would have to fit between the upper and lower bars of the carriage (see Fig. 1, parts 22 and 28, respectively). It does not appear from Figure 1 that there is sufficient space to accommodate a fork positioner (such as the one disclosed in the '790 Publication) between the upper and lower bars of the carriage. The '292 Publication teaches that the lower bar is connected to the underside of the upper bar (see last paragraph of pg. 4 of the English translation). This further supports the position that there is insufficient space between the upper and lower bars to accommodate a fork positioner.

Finally, the lower member of the side shift frame disclosed in the '292 Publication is shorter than the upper member (see parts 34 and 32 of Fig. 1). This gives the side shift frame a narrowing shape from top to bottom and requires the sides of the side shift frame to be curved (see parts 36, 38 of Fig. 1). Any fork positioner would have to fit in between these curved sides. The '790 Publication teaches that the fork positioner disclosed therein is to be used with a rectangular side shift frame (see Figs. 3 and 4). Even if a fork positioner was capable of being installed in the side shift frame of the '292 Publication, it would not be effective because the range of fork positioning between the narrow sides of the side shift frame would be severely restricted.

Accordingly, the side shifter disclosed in the '292 Publication cannot be combined with the fork positioners of either the '709 Publication or the Brochure without redesigning this side shifter to accept a fork positioner. The Applicant respectfully submits that such a redesign would not be obvious to a mechanic with ordinary skill in the art.

Furthermore, the combination side shifter fork positioner disclosed in the Brochure is an integrally constructed assembly where the side shifting and fork positioning functions are highly integrated in the design, and cannot be easily separated. In order to combine the fork positioner of the Brochure with the side shifter of the '292 Publication, one would have to first remove the side shifting functionality from the DSI design and then modify it to function with the side shifter of the '292 Publication. Such a task would require a complete redesign of the DSI design and would necessarily involve inventive skill. Furthermore, there is no disclosure in the Brochure which hints at such a redesign. In fact, there would be no reason to consider such a redesign because both the fork positioning and side shifting capability are already provided.

For all of the above reasons, the Applicant respectfully submits that claims 1, 14, and 21 of the present application are allowable. Because claims 2-13 and 15-20 depend from allowable independent claims, the applicant respectfully submits that these claims are also allowable.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

MONDANI et al
Appl. No. 10/078,521
February 12, 2004

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
Michelle N. Lester
Reg. No. 32,331

MNL:slj
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100